

REMARKS/ARGUMENTS

Favorable reconsideration of this application, as presently amended and in light of the following discussion, is respectfully requested.

Claims 1, 4-6, 9-11, 14-18, 21-26, 28, 30-35, 41, 43, 45, 47, and 49 are pending in the present application, Claims 1, 10, 11, 16, 20, 28, and 30-35 having been amended, and Claims 3 and 13 having been canceled without prejudice or disclaimer. Support for the amendments to Claims 1, 10, 11, 16, 20, 28, and 30-35 is found, for example, in paragraphs [0025] and [0026] of the originally filed specification. Applicant respectfully submits that no new matter is added.

In the outstanding Office Action, Claims 1, 3-6, 9-11, 13-18, 41, 43, and 49 were rejected under 35 U.S.C. §112, first paragraph, for failing to comply with the written description requirement; Claims 1, 11, 28, 30, 33, 34, 41, 43, and 47 were rejected under 35 U.S.C. §103(a) as unpatentable over Nishio (U.S. Patent Publication No. 2005/0251569) in view of Denman et al. (U.S. Patent No. 6,745,240, hereinafter Denman), and further in view of Morikawa et al. (U.S. Patent No. 7,027,169); Claim 35 was rejected under 35 U.S.C. §103(a) as unpatentable over Nishio in view of Denman and Morikawa, and further in view of Carcerano et al. (U.S. Patent No. 6,308,205); Claims 3-5, 13, 21-24, 26, 31, 32, 45, and 49 were rejected under 35 U.S.C. §103(a) as unpatentable over Nishio in view of Denman and Morikawa, and further in view of Duvvury (U.S. Patent No. 6,917,626); Claims 6 and 25 were rejected under 35 U.S.C. §103(a) as unpatentable over Nishio in view of Denman, Morikawa, and Duvvury, and further in view of Carcerano; Claims 9, 10, 14, and 15 were rejected under 35 U.S.C. §103(a) as unpatentable over Nishio in view of Denman and Morikawa, and further in view of Frazier et al. (U.S. Patent No. 6,981,025, hereinafter Frazier); Claims 17 and 18 were rejected under 35 U.S.C. §103(a) as unpatentable over Nishio in view of Denman, Morikawa, and Frazier, and further in view of Carcerano; and

Claim 16 was rejected under 35 U.S.C. §103(a) as unpatentable over Nishio in view of Denman, Morikawa, Frazier, and further in view of Duvvury.

Applicant respectfully traverses the rejection under 35 U.S.C. §112, first paragraph. Applicant respectfully submits that the pending claims comply with the written description requirement.

With respect to the written description requirement, there is no *in haec verba* requirement, and claim limitations may be supported by the specification through ***express, implicit, or inherent*** disclosure.¹ To satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention.²

If a skilled artisan would have understood the inventor to be in possession of the claimed invention at the time of filing, even if every nuance of the claims is not explicitly described in the specification, then the adequate description requirement is met. See, e.g., *Vas-Cath*, 935 F.2d at 1563, 19 USPQ2d at 1116; *Martin v. Johnson*, 454 F.2d 746, 751, 172 USPQ 391, 395 (CCPA 1972) (stating "the description need not be in *ipsis verbis* [i.e., "in the same words"] to be sufficient").

Thus, the exact phrase "comparing unit configured to compare" not appearing in the specification is an insufficient basis for concluding lack of written description.

The analysis of whether the specification complies with the written description "is conducted from the standpoint of one of skill in the art. Generally, there is an inverse correlation between the level of skill and knowledge in the art and the specificity of disclosure necessary to satisfy the written description requirement."³

¹ MPEP §2163.

² *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555 (Fed. Cir. 1991).

³ Page A-7 of the USPTO's *Written Description Training Materials*, revision 1, March 25, 2008.

Moreover, the MPEP discusses several factors that must be considered in order to make a 112, first paragraph, rejection for lack of written description. The MPEP states:

Whether the specification shows that applicant was in possession of the claimed invention is not a single, simple determination, but rather is a factual determination reached by considering a number of factors. Factors to be considered in determining whether there is sufficient evidence of possession include the level of skill and knowledge in the art, partial structure, physical and/or chemical properties, functional characteristics alone or coupled with a known or disclosed correlation between structure and function, and the method of making the claimed invention.

* * * *

The description needed to satisfy the requirements of 35 U.S.C. 112 "varies with the nature and scope of the invention at issue, and with the scientific and technologic knowledge already in existence." *Capon v. Eshhar*, 418 F.3d at 1357, 76 USPQ2d at 1084.

* * * *

Thus, an inventor is not required to describe every detail of his invention. An applicant's disclosure obligation varies according to the art to which the invention pertains. Disclosing a microprocessor capable of performing certain functions is sufficient to satisfy the requirement of section 112, first paragraph, when one skilled in the relevant art would understand what is intended and know how to carry it out.⁴

The outstanding Office Action fails to provide any explicit analysis as to the above-noted factors, which are pertinent to a determination of compliance with the written description requirement. Thus, the outstanding Office Action has failed to set forth a *prima facie* case of failing to comply with the written description requirement.

Furthermore, as explained by paragraph [0024] of the originally filed specification, management controller 110 is a non-limiting example of the claimed "comparing unit." Thus, a person of ordinary skill in the art would recognize that the inventor was in possession

⁴ MPEP §2163, emphasis added.

of the claimed invention at the time of filing and the written description requirement is satisfied.

With respect to the rejection of Claim 3, the subject matter of which is now included in Claim 1, as unpatentable over Nishio, Denman, Morikawa, and Duvvury, Applicant respectfully traverses this ground of rejection. Amended Claim 1 recites, *inter alia*,

a setting unit configured to set a default URL for said web server to correspond to a web server of the managing image forming device selected by the selection unit, wherein default URLs of web servers in the plurality of other image forming devices are also set to correspond to the web server of the managing image forming device.

Nishio, Denman, Morikawa, and Duvvury, taken alone or in proper combination, do not disclose or suggest at least this feature of amended Claim 1.

Initially, it is noted that in a non-limiting embodiment of the invention defined by Claim 1, there are a plurality of image forming devices connected to a network. One of the image forming devices is selected to be a managing image forming device. The non-managing image forming devices (i.e., the other image forming devices) set a default URL of their web servers to correspond to a web server of the managing image forming device. Accordingly, no matter which device a user tries to access, the user is routed to the selected managing image forming device so that the user can receive data (i.e., status, error messages, etc.) and/or send requests or data to the centralized management device. The user can thus access and/or manage devices on the network through the managing image forming device.⁵

When rejecting Claim 3, page 15 of the Office Action states “Nishio-Denman-Morikawa discloses the invention substantially as disclosed in claim 1, but does not explicitly teach a web server; a setting unit configured to set a default URL for said web server to correspond to a web server of the managing device.” The Office Action relies upon Duvvury

⁵ See, paragraph [0027] of the originally filed specification.

to cure the deficiency in Nishio, Denman, and Morikawa. Applicant respectfully traverses this position.

The outstanding Office Action cites to the Abstract of Duvvury and takes the position that Duvvury states “[e]ach device in the cluster is identified by URL, see (Duvvury, abstract, lines 1-8).⁶ However, Duvvury actually states “[e]ach device in the cluster is identified by a *unique* Universal Resource Locator (‘URL’).” Since the setting unit of Claim 1 sets a default URL of the web server to correspond to a web server of the managing image forming device, the default URL of the web server is not a unique URL. Duvvury does not disclose or suggest a group of network devices, each with a default URL of its own web server set to a web server of a managing image forming device.

Thus, Duvvury does not disclose or suggest the claimed:

a setting unit configured to set a default URL for said web server to correspond to a web server of the managing image forming device selected by the selection unit, wherein default URLs of web servers in the plurality of other image forming devices are also set to correspond to the web server of the managing image forming device.

Thus, Applicant respectfully submits that Claim 1 (and any claims dependent thereon) patentably distinguish over Nishio, Denman, Morikawa, and Duvvury, taken alone or in proper combination. Claims 11, 21, and 28 recite elements similar to those of Claim 1. Claims 11, 21, and 28 (and any claims dependent thereon) patentably distinguish over Nishio, Denman, Morikawa, and Duvvury, taken alone or in proper combination, for at least the reasons stated for Claim 1.

Addressing each of the further rejections, each of the further rejections is also traversed by the present response as no teachings in any of the further cited references to Carcerano and Frazier can overcome the above-noted deficiencies of Nishio, Denman,

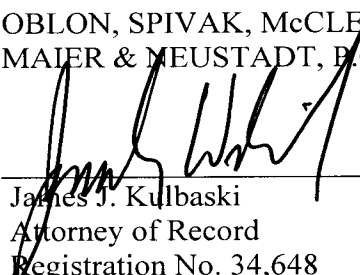
⁶ Office Action, page 15, lines 16-17.

Morikawa, and Duvvury. Accordingly, it is respectfully requested that those rejections be withdrawn for similar reasons as discussed above.

Consequently, in light of the above discussion and in view of the present amendment, the present application is believed to be in condition for allowance and an early and favorable action to that effect is respectfully requested.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



James J. Kulbaski
Attorney of Record
Registration No. 34,648

Customer Number

22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 08/07)

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Joseph Wrkich
Registration No. 53,796